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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,309	12/04/2003	Fred Bishop	03292.101680.1	1308
66569 7:590 09/14/2007 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SHAH, AMEE A	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/707,309

Applicant(s)

BISHOP ET AL.

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-18 are pending in this action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 9, 2007, has been entered.

#### ***Response to Amendment***

Applicant's Amendment and Remarks, filed April 9, 2007, have been entered. Claims 1-13 have been amended. Claim 18 has been added.

Newly submitted claim 18 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 1-17 and claim 18 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of claim 18 has separate utility such as authenticating the consumer. See MPEP § 806.05(d). Furthermore, applicant envisions claim 18 as a separate invention and distinct as indicated by the preambles, i.e. claim 18 is directed to a method for controlling offer and acceptance communications

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whereas claims 1-17 are directed to a method and apparatus for facilitating interactions between consumers and merchants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 18 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

However, the amendments to the specification regarding trademark use do not fully comply in that the trademarks are not capitalized, and the objection remains.

### *Specification*

The use of the trademarks MICROSOFT, WINDOWS, SOLARIS and others has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Examiner Note*

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that,

in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Angles et al., US 6,385,591 B1, cited in the previous Office Action (hereafter referred to as “Angles”) in view of Greenberg, US 2003/0144913 A1 (hereafter referred to as “Greenberg”).**

Referring to claim 1.

Angles teaches a method performed by an interface device for facilitating interaction between a consumer and a merchant (*see, e.g.*, Figure 3). Angles teaches an advertisement provider, which could be a computer, server or program (col. 13, lines 34-59), as the interface device as defined by the applicant (specification, ¶0017), receiving offer information from a content provider, i.e. merchant, via an electronic page or interactive television page with an embedded advertisement request, i.e. a broadcast that reaches a plurality of potential consumers, wherein said offer information relates to a product (*e.g.* Fig. 3, col. 7, line 65 through col. 8, line 43 and col. 9, lines 37-44). Angles further teaches the advertisement provider retrieving consumer preference information from a demographic database associated with the consumer (*e.g.* Fig. 3, col. 8, lines 19-24 and line 61 through col. 9, line 1, and col. 19, lines 53-63), amending the electronic page with an advertisement customized according to the consumer preference information, i.e. customizing the offer information received from the merchant via the broadcast according to the consumer preference information to create an amended offer for the consumer (*e.g.* Fig. 3, col. 8, lines 24-30, col. 9, lines 1-4 and col. 20, line 60 through col. 21, line 18), and transmitting the amended offer to a display for viewing by the consumer (*e.g.* Fig. 3, col. 8, lines 28-30 and col. 9, lines 5-10).

Greenberg, in the same field of endeavor of electronic shopping, teaches a method and apparatus for conducting electronic commerce where an email offer is sent to prospective customers, such offer specifying a method of acceptance (Fig. 2 and pages 1-2, ¶¶0016 and 0018 – note the method of acceptance is the “Purchase ‘button’”), an acceptance is received from the

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consumer, wherein the acceptance is associated with the offer and the acceptance includes a security feature of an identifier transmitted from a communication device used to perform the acceptance (Figs. 2 and 3, and page 2, ¶¶0018 – note the security feature can be either the one embedded on a credit card or the SSL handshaking and certificate exchange, both identifiers and which can be transmitted from a communication device such as a computer), the acceptance is amended with consumer payment information and identification information to create an amended acceptance (page 2, ¶¶0021 – note the consumer payment information and identification are in the email in advance and the amended acceptance is performed by activating the “Purchase Using Default Options” button); and the amended acceptance is transmitted to the merchant (Fig. 3 and page 2, ¶¶0019 and 0021 – note the transmittal is performed by notifying the merchant server).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of specifying a method of acceptance, receiving an acceptance associated with the offer and with a security feature, amending the acceptance with payment and identification information and transmitting the amended acceptance to the merchant, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of allowing for an electronic purchase to be conducted

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after an offer to sell is made, thereby leading to more business transactions completed and more profit.

Referring to claim 2. Angles in view of Greenberg further teaches the method of claim 1 wherein the step of transmitting the amended offer to a display includes transmitting via at least one of television programming and an Internet broadcast (Angles, col. 9, lines 37-44).

Referring to claim 3. Angles in view of Greenberg further teaches the method of claim 1 wherein the consumer preference information includes at least one of restriction information, demographic information, identification information, and shipping information (Angles, *e.g.*, col. 17, lines 15-22).

Referring to claim 4. Angles in view of Greenberg further teaches the method of claim 1 wherein the step of receiving an acceptance from the consumer includes receiving an acceptance via at least one of a remote control, an electronic pen, a telephone, an automatic dialing device, a microphone, a pager, a radio-frequency device, a personal digital assistant, a smart card, DVR, PVR, and simulated button (Angles, col. 10, lines 43-52 and Greenberg, pages 1-2, ¶0016 – note the computer can be a number of mechanisms, including a personal digital assistance, interactive television and wireless device, and that the acceptance can be any mechanism, including a mouse click, to indicate acceptance) in order to complete and effect a purchase.



Referring to claim 5. Angles in view of Greenberg teaches the method of claim 1 wherein the acceptance includes a security feature including at least one of authentication, embedded certificate, consumer ID and password, identifier, data-encryption information, digital signature, secure file structures, and trusted third party downloads (Greenberg, Figs. 2 and 3, and page 2, ¶¶ 0018, 0021 and 0022 – note the security feature can be consumer ID and password, the one embedded on a credit card or the SSL handshaking and certificate exchange). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of a security feature to an acceptance, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of preventing fraudulent purchases and/or uses of credit cards.

Referring to claim 6. Angles in view of Greenberg also teaches the method of claim 1 wherein the consumer preference information is provided to the database in a registration process performed by the consumer (Angles, col. 14, lines 22-63 and col. 17, lines 1-51).

Referring to claim 7. Angles in view of Greenberg also teaches the method of claim 1 further comprising the steps of authenticating the consumer (Angles, col. 19, lines 53-63 – note the authentication is extracting the consumer code and determining whether the user has

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registered), and managing consumer identities (Angles, *e.g.*, col. 16, lines 10-19 – note the management of consumer identities is the storing of information based on the consumer code).

Referring to claim 8. Angles in view of Greenberg also teaches the method of claim 1 further comprising the step of analyzing attributes of the consumer to substantially predict an optimal offer content and context (Angles, *e.g.*, col. 16, lines 10-19 – note the analysis is based on consumer profile).

Referring to claim 9. Angles in view of Greenberg further teaches the method of claim 1 wherein the step of amending includes amending the acceptance with at least one of consumer loyalty point information, authorization from an issuer, authorization from said system, security or wallet server authorization, consumer authentication and single use account number information (Greenberg, page 2, ¶0021 – note the acceptance includes authorization from user, security server authorization and single use account number information from credit card). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of amending the acceptance with authorization, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of completing transactions in a timely manner.

Referring to claim 10. Angles in view of Greenberg also teaches the method of claim 1 further comprising the step of developing at least one of a consumer transaction database and an offer evaluation database (Angles, col. 16, lines 10-20).

Referring to claim 11. Angles in view of Greenberg further teaches the method of claim 1 wherein the step of transmitting the amended acceptance to the merchant includes at least one of authenticating the consumer and authorizing a transaction between the consumer and the merchant (Greenberg, Fig. 3 and page 2, ¶¶0019 and 0021). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of authenticating the consumer and authorizing a transaction, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of completing the transaction.

Referring to claims 12, 13, and 15-17. All of the limitations in apparatus claims 12, 13, 16 and 17 are closely parallel to the limitations of method claims 1-11, analyzed above and are rejected on the same bases.

Referring to claim 14. Angles in view of Greenberg also teaches the interface device of claim 12 wherein the application program causes the processor to perform a step of storing the offer information in an offer database (Angles, col. 12, lines 1-11 – note the offer database is the advertising storage medium).

### ***Response to Arguments***

Applicant's arguments filed April 9, 2007, have been fully considered but they are not persuasive. In response to applicant's argument that Angles does not teach an interface device customizing the offer information received from the merchant broadcast according to the who performs the customization in Angles and when (Remarks, pages 11-12), the Examiner disagrees. As discussed above, Angles teaches an advertising provider, i.e. an interface device, customizing offers after a broadcast, i.e. an electronic page with an embedded request, is sent to the provider.

In response to applicant's argument that Greenberg does not teach an interface device receiving acceptance information (Remarks, pages 12-13), applicant argues against the references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Greenberg teaches the known elements of amending acceptances with security features and payment information, and receiving acceptance information. As discussed above, it would be obvious to combine these known elements with the steps and interface device of Angles.

***Conclusion***

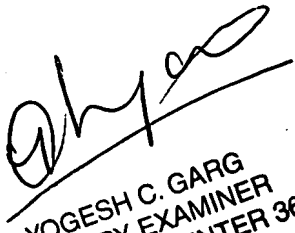
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

September 7, 2007

  
YOGESH C. GARG  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600